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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,951	08/14/2006	Wataru Ikeda	KIK-41079	8315
116 7590 10/24/2011 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER KHATRI, PRASHANT J	
			ART UNIT 1783	PAPER NUMBER
			MAIL DATE 10/24/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/597,951

Applicant(s)

IKEDA ET AL.

Examiner

PRASHANT J. KHATRI

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 41-46 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 41-46 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/25/2011
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

In response to Amendments/Arguments filed 7/22/2011. Claims 41-46 are pending.

Claim 41 was amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 41-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobunao et al. (***JP 2001-315287***).

3. Nobunao et al. disclose a decorative material. Concerning claims 41 and 44, Nobunao et al. disclose an article having a surface decorative layer that is comprised of a resin absorptivity patterned ink that is colored with particles and a topcoat resin layer wherein at least a portion of the topcoat resin layer is absorbed by the resin absorptive pattern (***Abstract; FIGS. 1-2; para. 0054***). The topcoat resin layer can be comprised of a non-solvent (i.e. aqueous) UV hardening material based upon a human spot translation of these paragraphs (***para. 0034-0035, 0058***). Regarding the amount of low gloss and high gloss regions, Nobunao discloses that the composition has a surface gloss that is high and that the gloss can be adjusted with the use of matting agents (***para. 0059***). Given that Nobunao discloses controlling the gloss by means of matting

agents, it is clear that one of ordinary skill in the art would have been able to control the gloss by controlling the amount of matting agents. Further, given that Nobunao discloses that the ink layer is patterned and may be colored, the one of ordinary skill in the art would be able to form a desired pattern that would allow for greater and lesser amounts of hardening resin based upon the amount of ink that is disposed upon the surface absorbed since a pattern intrinsically would have portions where there is ink and where there is no ink or little ink (i.e. varies based upon the pattern that is disposed) and as such, lesser and greater absorbed regions (**FIGS. 1-2; para. 0049-0056**).

Concerning claim 43, it is noted that the topcoat resin layer would have matting agents (**para. 0059**).

While it is noted that Nobunao is silent to such a layer applied to the article by means of transfer under water pressure, it is noted that such a limitation is a product-by-process limitation. Although Nobunao et al. does not disclose the use of such a layer as applied to the surface of an article by transfer under water pressure, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed

product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed transfer under water pressure and given that Nobunao et al. meets the requirements of the claimed composite, Nobunao et al. clearly meet the requirements of present claims 41 and 46.

4. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nobunao et al. (***JP 2001-315287***) as applied to claim 41 above, and further in view of Wypych (***Book***).

5. Nobunao discloses the above but is silent to the particle colorant being black. Wypych discloses carbon black as pigment for ink compositions in which the use of carbon black in creating tinted inks is known within the art as far back as 3000 B.C. (***p. 62-71***). Given that Nobunao discloses formulating printing inks with colorants that include particles (***para. 0054***) and Wypych discloses carbon black is used in printing inks, it is clear that such materials are well-known within the art and would have been obvious to one of ordinary skill in the art to use accordingly.

Response to Arguments

6. Applicant's arguments, see p. 5-6, filed 7/22/2011, with respect to the 35 USC 112, 2nd paragraph rejection of claims 41-46 have been fully considered and are persuasive. The rejection of the above claims has been withdrawn.

7. Applicant's arguments filed 7/22/2011 with respect to the Nobunao rejection have been fully considered but they are not persuasive. Applicant asserts that the top coat resin does not comprise a UV hardening resin composite. Examiner respectfully disagrees and notes that Nobunao teaches that the top coat (i.e. element 6) is in fact comprised of the same resins as that of the anti-abrasive resins which are UV hardening (*para. 0058*). Furthermore, as shown in Figures 1 and 2, the layer as shown is single layer of a resin and ink pattern. As such, materials are "wholly united". Examiner also notes that Nobunao in the cited paragraphs regarding the ink, it is noted that the pigment particle itself can be the extender which is regarded by Nobunao as absorbing the resin (*para. 0054*). Examiner also notes that a pattern having lesser and greater amounts of inks to form a desired image would contain particles in lesser and greater amounts. Therefore, a pattern containing areas of greater and lesser amounts of inks that would form a pattern of areas that absorb greater and lesser amounts of resin. As such, Nobunao clearly teaches the present independent claim. Applicant further asserts that Nobunao does not teach the amount of absorbing resin controls the gloss. Examiner notes that claim 42 does not recite that the amount of absorbing resin in each area corresponds to the gloss differential. The use of matting agents with pigmented ink as shown by Nobunao can be used to control the gloss and as such meets the instant limitations. As such, the rejection is maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRASHANT J. KHATRI whose telephone number is (571)270-3470. The examiner can normally be reached on M-F 9:00 A.M.-5:00 P.M. (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1783

PRASHANT J KHATRI
Examiner
Art Unit 1783

/P. J. K./
Examiner, Art Unit 1783